

Attorney Docket No.: **PENN-0798**
Inventors: **Clevenger and Ryczyn**
Serial No.: **10/049,562**
Filing Date: **July 8, 2002**
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REMARKS

Claims 1-10 are pending in the instant application. Claims 1-6, 9, and 10 have been subjected to a restriction requirement. Claims 1-6, 9, and 10 have been canceled. Claims 7 and 8 have been rejected. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

I. Election/Restriction Requirement Under 35 U.S.C. §121

Because Applicants' response filed February 22, 2005 contained a new listing of claims, the claims of the present application have been subjected to a supplemental Restriction Requirement under 35 U.S.C. §121 and 372 as follows:

Group I, claims 1-2, drawn to a composition for modulating somatolactogenic function comprising cyclophilin B;

Group II, claims 1-2, drawn to a composition for modulating somatolactogenic function comprising a mutant cyclophilin B;

Group III, claims 1-2, drawn to a composition for modulating somatolactogenic function comprising an inhibitor of the interaction of cyclophilin B with a somatolactogenic hormone;

Group IV, claims 3-4, drawn to a method for modulating somatolactogenic function in an animal comprising administering a mutant of cyclophilin B;

Group V, claims 3 and 5-6, drawn to a method for modulating somatolactogenic function in an animal comprising administering a mutant cyclophilin B;

Group VI, claims 3 and 5-6, drawn to a method for modulating somatolactogenic function in an animal comprising administering

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an inhibitor of the interaction of cyclophilin B with a somatolactogenic hormone;

Group VII, claims 7 and 8, drawn to a method for identifying test compounds as inhibitors of somatolactogenic functions comprising assessing the ability of a test compound to inhibit the interaction of cyclophilin B with a somatolactogenic hormone; and

Group VIII, claims 9 and 10, drawn to a method for diagnosing diseases associated with abnormal somatolactogenic functions comprising obtaining a biological sample, and comparing cyclophilin B levels in the patient with cyclophilin B levels of a normal individual.

The Examiner suggests that the inventions listed as Groups I-VIII are independent and distinct from each other as they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicants are required to elect one of the Groups to be examined. The Examiner acknowledges Applicants' election with traverse of Group IV, claims 7-8, in response to the previous office action mailed October 20, 2004 and because these claims remain together in Group VII of the supplemental Restriction Requirement, the Examiner has examined claim 7-8 of Group VII. In an effort to facilitate the prosecution of the instant application, Applicants hereby elect to prosecute Group VII, claims 7 and 8, and have canceled claims 1-6, 9, and 10 without prejudice, reserving the right to file continuing applications for the canceled subject matter.

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II. Status of the Application

The Examiner has acknowledged priority to U.S. Provisional Application No. 60/149,752 filed August 19, 1999; receipt of the Information Disclosure Statement filed February 14, 2002; and receipt and entry of the sequence listing filed February 14, 2002.

III. Rejection of Claims under 35 U.S.C. §112

Claims 7-8 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. Specifically, the Examiner suggests that the term "somatolactogenic hormone" is unclear as to the metes and bounds it imparts on the claimed subject matter. It is suggested that the specification does not define the term "somatolactogenic hormone" and the art does not clearly define this term with a single meaning. Applicants respectfully traverse this rejection.

The term somatolactogenic hormone was a well-known term in the art at the time of filing. For example, Arkins et al. ((1993) *J. Dairy Science* 75:2437-2450; enclosed herewith) teaches that somatolactogenic hormones prolactin, growth hormone, and placental lactogen, belong to the somatolactogen family of hormones by virtue of shared biological, immunological, and structural feature (see page 2438, first full paragraph). The proteins are of similar size and globular structure with approximately equal α -helical content. The use of the term somatolactogenic hormone in the instant application is consistent with these prior art teachings. For example, page 5, lines 2-4, of the instant application clearly provides a functional

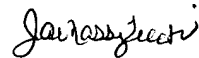
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definition of what constitutes a somatolactogenic hormone, i.e., a hormone involved in the development of breast and prostate cancer, growth and the immune response. Specific examples of somatolactogenic hormones, i.e., prolactin and growth hormone, are also provided in this passage. Accordingly, one possessing an ordinary level of skill in the pertinent art at the time the invention was made could clearly interpret the scope of the claims with clarity and precision in view of the functional definition and examples provided in the instant application and the teachings of the prior art. MPEP 2173.02. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

IV. Conclusion

The Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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